

Remarks

This Application has been carefully reviewed in light of the Office Action mailed October 31, 2002. Because Applicant believes all claims are allowable as previously presented, Applicant has made no amendments but presents these remarks for consideration. Applicant respectfully requests reconsideration and full allowance of all pending claims.

The Claims are Allowable over *Guck* in view of *Slaughter*

The Examiner rejects Claims 2-8, 10-18, and 20-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,911,776 to *Guck* in view of U.S. Patent 6,421,787 to *Slaughter et al.* ("*Slaughter*"). Applicant respectfully disagrees.

At a minimum, the proposed *Guck-Slaughter* combination does not disclose, teach, or suggest the following limitations recited in Applicant's independent Claims 6, 15, and 25: (1) first and second versions of a single business application being identified using first and second version identifiers, respectively, and being executable by first and second clients, respectively, to perform a business process; (2) that the first version of the single business application is operable to determine the first and second version identifiers, exercise control over execution of the business process if the first version is higher than the second version, and allow the second version of the single business application to exercise control over execution of the business process if the second version is higher than the first version. The portions of *Guck* relied on by the Examiner merely disclose the use of shadow files and corresponding converters to allow an original source file to be transformed into other formats according to particular needs of requesting clients. (See Abstract; Column 1, Lines 24-30; Column 4, Lines 41-54; Column 4, Line 66 – Column 5, Line 25)

In attempting to apply *Guck* to Applicant's claims, the Examiner applies "the process of enabling an author to create and store an original document" as disclosed in *Guck* against Applicant's recited first version of the single business application. The Examiner further applies "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" as disclosed in *Guck* against Applicant's recited second version of the single business application. However, even assuming for the sake of argument that these processes could be

equated with business applications, Applicant's independent Claims 6, 15, and 25 make clear that the recited first and second versions executable by the first and second clients, respectively, are two versions of the same business application rather than two wholly different business applications as the Examiner's argument requires.

Following the Examiner's reasoning, for *Guck* to be applied against Applicant's independent Claims 6, 15, and 25, "the process of enabling an author to create and store an original document" (which the Examiner applies against Applicant's recited first version of the single business application) would need to be operable to: (1) determine a first version identifier for itself; (2) determine a second version identifier for "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application); (3) exercise control over enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Applicant's recited business process) if its version is higher than the version of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application); and (4) allow "the process of updating and retrieve to exercise control over execution of enabling "an author to create and store an original document, as a source file with a first format" (which the Examiner applies against Applicant's recited business process) if the version of "the process of updating and retrieve information as files or file-converter and then published in any specific format to multiple numbers of and type of receiving appliances" (which the Examiner applies against Applicant's recited second version of the single business application) is higher than its version. Applicant respectfully submits that, not only does the above make little if any sense, but the above certainly is not disclosed, taught, or suggested in *Guck*, whether *Guck* is considered alone or in combination with any other cited reference or with knowledge generally available to one skilled in the art at the time of the invention.

The Examiner appears to acknowledge that *Guck* fails to disclose that the first version of the single business application is operable: (1) if the first version is higher than the second

version, to exercise control over execution of the business process; and (2) if the second version is higher than the first version, to allow the second version of the single business application to exercise control over execution of the business process. (See Office Action, Page 3) Applicant respectfully notes that these elements acknowledged to be missing from the primary reference *Guck* constitute two of the three total elements in each of Applicant's independent Claims 6, 15, and 25. To account for these missing elements, the Examiner appears to equate first and second user protocols with Applicant's recited first and second versions of the single business application, respectively; cites a portion of the secondary reference *Slaughter* disclosing that a protocol faster than TCP/IP may be used for data communications (See Column 10, Lines 8-15); and states that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the format conversion of *Guck* by including a faster protocol as taught by *Slaughter* because such modification would provide the format conversion of *Guck* with the enhanced necessary to have a faster network communication or business process." Applicant respectfully submits that this is entirely insufficient to support an obviousness rejection under 35 U.S.C. § 103(a) under the M.P.E.P. and governing Federal Circuit case law.

Furthermore, even assuming for the sake of argument that *Slaughter* was analogous art, the rejection of Claims 6, 15, and 25 would still be improper because the Examiner has not shown the required suggestion or motivation in *Guck*, *Slaughter*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (emphasis in original). Thus, the mere fact that the teachings of one reference might possibly improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. Nothing in *Guck*, *Slaughter*, or any other cited reference suggests or motivates the proposed combination, nor has the Examiner provided specific evidence that suggests or motivates the proposed combination.¹ Applicant respectfully notes that speculation in hindsight that "it would have

¹ If "common knowledge" or "well known" art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

been obvious" to make the proposed combination because the proposed combination might be helpful is insufficient under the M.P.E.P.² and governing Federal Circuit case law.³

Moreover, even assuming for the sake of argument that *Slaughter* was analogous art and that there was the required suggestion or motivation to combine *Guck* with *Slaughter*, the proposed *Guck-Slaughter* combination still would not disclose the limitations specifically recited in Applicant's independent Claims 6, 15, and 25 as discussed above. This is true whether the proposed *Guck-Slaughter* combination is considered alone, in combination with one or more other cited references, or in combination with information generally known to those skilled in the art at the time of the invention.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 6, 15, and 25, together with all claims that depend on these claims.

² See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

³ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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